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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,266	09/22/2003	Michael A.N. Scobie	62276-1512	7761
20736	7590	08/16/2006	EXAMINER	
MANELLI DENISON & SELTER 2000 M STREET NW SUITE 700 WASHINGTON, DC 20036-3307			HALPERN, MARK	
			ART UNIT	PAPER NUMBER
			1731	

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/666,266	<b>Applicant(s)</b> SCOBIE, MICHAEL A.N.	
	<b>Examiner</b> Mark Halpern	<b>Art Unit</b> 1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 13-38 is/are pending in the application.
- 4a) Of the above claim(s) 27-38 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 13-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____.  |

### DETAILED ACTION

1) A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/8/2006, has been entered, wherein claims 1, 13, 15, 18, 20 are amended, and new claims 27-38 are offered for consideration.

Newly submitted claims 27-38 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: the claims introduce a concept of structure having "a strength to weight ratio greater than carbon steel such that the structural member retains its shape at loads which deform steel having a same weight and footprint as the structural member".

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-38, are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2) Claims 1-11, 14, 16-17, are rejected under 35 U.S.C. 102(b) as being anticipated by Betzner (6,068,804).

Claims 1-3, 10-11: Betzner discloses a process of making a fiberboard that includes the steps of forming a slurry that includes lignocellulose fibrous materials (col. 4, lines 16-30) and asphalt, mixing the slurry to uniformly distribute the components, dewatering the slurry to form a wet mat, pressing the wet mat in a pressing means under pressure to make it uniformly consolidated, and drying the mat for a duration of time at a temperature range (Abstract, and Figures 1-3). The finished mat is of thickness in the range of 3/8 - 3/4 inches (col. 7, lines 1-4).

Claims 4-7: the fiber length 0.25 mm to 13 mm (col. 2, lines 34-38).

Claim 8: the fiber consistency in the aqueous slurry is in range of 0.5% to 8% by weight (col. 2, lines 19-21).

Claim 9: the bulk density is 18-25 lbs/ft<sup>3</sup> (col. 2, lines 20-25).

Claim 14: fibers of wood pulp, bagase, straw are disclosed (col. 2, lines 29-33, col. 4, lines 16-30).

Claims 16-17: the formed board contains 0-5% water by weight (col. 6, lines 29-31).

3) Claims 23-24 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Betzner. Betzner discloses a process of making a fiberboard that includes the steps of forming a slurry that includes lignocellulose fibrous materials and asphalt, mixing the slurry to uniformly distribute the components, dewatering the slurry to form a wet mat, pressing the wet mat in a pressing means under pressure to make it uniformly consolidated, and drying the mat for a duration of time at a temperature range. The finished mat is of thickness in the range of 3/8 - 3/4 inches. Betzner thus discloses the claimed product.

In the event any differences can be shown for the product of the product-by-process claims 23-24, as opposed to the product taught by the reference Betzner, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

4) Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Betzner. Betzner is applied as above for claim 1, Betzner fails to disclose pressure of claimed

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range during pressing, however, it would have been obvious to one skilled in the art at the time the invention was made, that the pressure applied during the mat formation would be in the range claimed, based on the design requirements of the resulting product.

5) Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Betzner in view of Bodary (6,086,720). Betzner is applied as above for claim 1, Betzner fails to disclose drying by air drying. Bodary discloses a process of making a fibrous product from a slurry, wherein drying is performed by drawing air through the product made. It would have been obvious to one skilled in the art at the time the invention was made, to combine the teachings of Betzner and Bodary, because such a combination by the use of air drying would reduce the drying time in the making of the mat of Betzner.

6) Claims 18-22, 25-26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Betzner in view of Symons (6,403,000).

Claims 18-22: Betzner is applied as above for claim 1, Betzner does not disclose further impregnation in thermosetting resin followed by drying. Symons discloses the further step of impregnating the lignocellulose fiber material with a liquid thermosetting resin by pressing for a period of time and then drying. It would have been obvious to one skilled in the art at the time the invention was made, to combine the teachings of Betzner and Symons, because such a combination would provide strength to the product of Betzner and thus expand the product applicability and use.

Claims 25-26: Betzner is applied as above for claim 1. Symons discloses the further step of impregnating the lignocellulose fiber material with a liquid thermosetting

resin by pressing for a period of time and then drying. Betzner in view of Symons discloses the claimed product.

In the event any differences can be shown for the product of the product-by-process claims 25-26, as opposed to the product taught by the references Betzner and Symons, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also In re Thorpe, 227 USPQ 964 (Fed. Cir. 1985).

### ***Response to Amendment***

7) Applicant's arguments filed 8/8/2006, have been fully considered but they are not persuasive.

In regard to claim 1, which now recites "comprising essentially" Applicant alleges that cited prior art, Betzner, cannot be used since Betzner teaches of making a product that includes fibers and asphalt and rubber.

In response, the MPEP 2111.03 Transitional Phrases [R-3] is cited which teaches the following: For purposes of applying prior art absent a clear indication in the specification or claims of what the basic and novel characteristics actually are, "consisting essentially of" will be construed as equivalent to "comprising"; Applicant has the burden of showing that the introduction of additional steps or components would materially change the characteristics of the applicant's invention. Applicant has not shown that the addition of asphalt and rubber to fibers will change the characteristic of

the applicant invention; in fact the concept of providing a structural product that retains its shape under loads is not claimed.

Applicant alleges that claims 23 and 24 rejection is not proper.

Betzner, as per above, discloses the claimed product. In the event any differences can be shown for the product of the product-by-process claims 23-24, as opposed to the product taught by the reference Betzner, such differences would have been obvious to one of ordinary skill in the art as a routine modification of the product in the absence of a showing of unexpected results; see also *In re Thorpe*, 227 USPQ 964 (Fed. Cir. 1985).

Applicant alleges that Betzner is silent on further impregnation of resin into the dried fiber material.

Betzner does not disclose further impregnation in thermosetting resin followed by drying. Symons discloses the further step of impregnating the lignocellulose fiber material with a liquid thermosetting resin by pressing for a period of time and then drying. It would have been obvious to one skilled in the art at the time the invention was made, to combine the teachings of Betzner and Symons, because such a combination would provide strength to the product of Betzner and thus expand the product applicability and use.

Applicant alleges that Betzner does not teach the use of the present invention formed composite material as a structural member.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies



(i.e., the use of the formed composite material as a structural member) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant alleges that cited prior art, Betzner, Symons, Bodary, are not combinable and do not individually show the invention.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the references, Betzner, Symons, Bodary are properly combined.

***Conclusion***

8) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 571-272-1190. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read 'M. Halpern', with a stylized, flowing script.

Mark Halpern  
Primary Examiner  
Art Unit 1731